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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,997	01/24/2007	Takahito Itoh	0026.1225	3293
49455	7590	12/31/2009	EXAMINER	
STEIN MCEWEN, LLP			HU, HENRY S	
1400 EYE STREET, NW				
SUITE 300			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			1796	
			NOTIFICATION DATE	DELIVERY MODE
			12/31/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptomail@smiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/594,997	ITOH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	HENRY S. HU	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on IDS of March 24, 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-8 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 24 January 2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3-24-2008 and 9-29-2006.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

1. USPTO has received **two IDS'** (2 pages each) so far. This Application is a **371/PCT/JP05/006967** with a Japanese priority at April 9, 2004. Examiner **accepts Applicants' four drawing sheets with Figures 1-4.** Although some description is shown on working examples, **a brief description for drawing according to MPEP is still missing in the front specification.** **Claims 1-8 are pending now with three independent claims (Claim 1, Claim 4 and Claim 5).** An action follows. ("X" and "Y"-cited references are found in international search report for Applicants' priority document **PCT/JP2005/006967**)

## **DETAILED ACTION**

### ***Election/Restrictions***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner as well as by examining the references cited in international search report and IDS filed by Applicants.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following: It is noted that **three independent claims are marked with an underline.**

I. **Claims 1-3 and 8, drawn to a solid-state polymer electrolyte membrane,**

wherein a primary constituent of which is a hyperbranched polymer having an acidic functional group disposed at a terminal of a side chain thereof.

II. **Claim 4 and 8, drawn to a different solid-state polymer electrolyte membrane,**

wherein a mixture of a hyperbranched polymer having an acidic functional group disposed at a terminal of a side chain thereof and a bridged polymer having a network structure.

III. **Claims 5-7, drawn to a process of making a solid –state polymer electrolyte membrane.** Said process comprises **two** steps including: (A) a first step in which **poly(bis(oligo-ethylene glycol) benzoate) is synthesized** as specified, and (B) a second step in which **an acidic functional group is introduced at a terminal of a side chain** of the poly(bis(oligo-ethylene glycol) benzoate).

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "**special technical features**" shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I-III do not

relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of Examiner's own prior art search, search report for Applicants' priority document **371/PCT/JP05/006967**, and the references or articles cited in two IDS' filed so far by Applicants, **Claims 1-8** is either obvious or anticipated by following: **JP 10-340732 to Kyoko et al., JP 2003-327826 to Yoshimitsu et al., and JP 10-67847 to Toshihiro et al.**, each individually or in combination. In summary, these three groups have no common features in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, the hyperbranched polymer having an acidic functional group as disclosed on Group I does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate.

5. With respect to the fact that "all groups are structurally different each other", Group I and Group II is each drawn to different solid-state polymer electrolyte membrane, while Group III is drawn to a process of making a solid –state polymer electrolyte membrane. Attention is directed to the fact that only Group II requires the formation of a network structure. Although the subject matter from each group may comprise the same or at least similar hyperbranched polymer, function and application are indeed different. Groups I, II and III are thereby not functionally equivalent and interchangeable.

6. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that no phone call was made to **Michael D. Stein (registration # 37,240, tel: 202 216-9505)** by the examiner due to the complexity on multiple (three) distinct groups along with three independent claims. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1796

/Henry S. Hu/  
Examiner, Art Unit 1796

December 21, 2009